

**REMARKS**

Upon entry of the claim amendments, Claims 1-4 and 6-22 will be all the claims pending in the application.

Applicants have incorporated the subject matter of Claim 5 into Claim 1. Claim 5 has been canceled.

Claim 22 has been amended to render it consistent with amended Claim 1, as supported by the description at page 26, lines 11-15, of the specification.

No new matter has been added.

Claims 7-21 are presently withdrawn for being directed to a non-elected invention.

Each of withdrawn Claims 8, 10, and 12-21 is a process claim which depends from Claim 1. Thus, rejoinder of Claims 8, 10, and 12-21 is proper and requested upon the allowance of Claim 1. In this regard, where an applicant elects a claim directed to a product, and the product claim is subsequently found allowable, withdrawn process claims which depend from or otherwise include all the limitations of the allowable product claim will be rejoined. MPEP §821.04.

Referring to Section Nos. 4-7 at pages 2 and 3 of the Office Action, Claims 1-4 and 6 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,731,370 ("Shiobara").

Applicants respectfully traverse.

Independent Claim 1 (and its dependents) is not disclosed or suggested by Shiobara. For example, Claim 1 recites subject matter previously recited in Claim 5, which was not included in the present §103 rejection. For at least this reason, Applicants respectfully request withdrawal of the §103 rejection of Claims 1-4 and 6.

AMENDMENT  
U.S. Appln. No. 09/914,363

Referring to Section Nos. 8-9 at pages 3-5 of the Office Action, Claims 5 and 22 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Shiobara in view of Hosokawa (JP 10-168161).

Applicants respectfully traverse.

Independent Claim 1 (into which the subject matter from Claim 5 has been incorporated) recites that the resin composition for semiconductor encapsulation has a viscosity of 7,000 poise or more at 25°C and 5,000 poise or less at 80°C (referred to hereinafter as the “viscosity profile” of the claimed resin composition).

The Examiner asserts at page 2 of the Office Action that the claimed viscosity profile “is an inherent property of the resin disclosed by Shiobara.”

In relying upon a theory of inherency, however, a basis in fact and/or technical reasoning must be identified to support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied art. In the present case, no such basis has been identified with respect to the claimed viscosity profile.

Furthermore, the claimed resin composition has a significant advantage to have the claimed viscosity profile, wherein the significance is shown by the Examples and Comparative Examples of the specification. The results from the Examples and Comparative Examples are completely unexpected from the combination of Shiobara and Hosokawa.

For the foregoing reasons, Applicants respectfully request withdrawal of the §103 rejection of Claims 5 and 22.

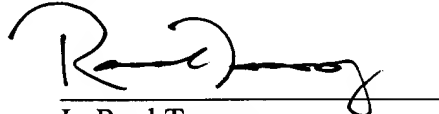
Reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

AMENDMENT

U.S. Appln. No. 09/914,363

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'L. Raul Tamayo', written over a horizontal line.

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